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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,941	03/01/2004	Joseph Miller	S63.2-10812-US01	2180

490 7590 12/20/2006  
VIDAS, ARRETT & STEINKRAUS, P.A.  
6109 BLUE CIRCLE DRIVE  
SUITE 2000  
MINNETONKA, MN 55343-9185

EXAMINER

COZART, JERMIE E

ART UNIT PAPER NUMBER

3726

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/790,941

Applicant(s)

MILLER ET AL.

Examiner

Jermie Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-22 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 3,8 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/06 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 5, 7, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ching et al. (US 6,481,262 B2).

Ching discloses positioning assembly of a crimper apparatus (10) comprising a first plate (20) and a second plate (50), the first plate having a nest (not labeled, fig. 2) located between ribs (24) to accommodate at least a portion of a first cylindrical member (60), the second plate (50) having a nest (not labeled, fig. 2) located between ribs (44) to accommodate at least a portion of the first cylindrical member (60) and/or at least a portion of the second cylindrical member, the first plate (20) constructed and arranged to be separated from the second plate in a first position. The first cylindrical

member and the second cylindrical member have a longitudinal axis extending in a longitudinal direction (Fig. 5). The first plate (20) and the second plate (50) are moveable relative to one another (col. 4, lines 26-30) in the longitudinal direction [see Fig. 2, i.e. the second plate (50) is inserted first and placed in member (30) then the first plate (20) is moved longitudinally so as slide above plate (50) into groove (34) of member (30)], in a first position [see Fig. 2, i.e. the second plate (50) is inserted first and placed in member (30) then the first plate (20) is moved longitudinally so as slide above plate (50) into groove (34) of member (30)] the first plate (20) is constructed and arranged to be separated from the second plate (50) in the longitudinal direction and in a second position (see fig. 1) the first plate (20) immediately adjacent to the second plate (50), when in the second position the first plate (20) and the second plate (50) situated such that the first cylindrical member and the second cylindrical member would be in predetermined placement for joining. The first plate (20) has a nest (described above, see also fig. 6) longitudinally aligned with a nest (described above, see also fig. 6) on the second plate (50). A first biasing member (i.e. user/operator's hands) maintains the first position when activated, and a second biasing member (52) maintains the second position when the first biasing member is not activated. The second biasing member comprises a spring loaded force (52). The first cylindrical member is a stent retaining member (not labeled, see fig. 6), and the second cylindrical member is a catheter tube (60). See column 3, line 64 – column 5, line 12, and figures 1, 2, and 6 for further clarification.

Note that the recitation for automatically positioning a first cylindrical member for crimping to a second cylindrical member has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Note that for the purposes of the above rejection, the longitudinal direction of the cylindrical members and the plates have been treated as being different, since the claims are directed solely to the positioning assembly and not the combination of the positioning assembly and first and second cylindrical members.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching et al. (US 6,481,262 B2).

Ching discloses the first cylindrical member being a catheter tube.

Ching, however, does not expressly disclose the second cylindrical member being the inner tube of a catheter. Ching also does not disclose the first biasing member being at least one solenoid.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use at least one solenoid as the first biasing member and to form the second cylindrical member as the inner tube of a catheter because Applicant has not disclosed that using at least one solenoid as the first biasing member or the second cylindrical member being the inner tube of a catheter provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the first biasing member being the hand of the operator/user and the second cylindrical member being a catheter tube because the user/operator's hand maintains the first position when activated and the first cylindrical member is fixedly secured on the catheter tube.

Therefore, it would have been an obvious matter of design choice to modify Ching to obtain the invention as specified in claims 6 and 12.

### ***Response to Arguments***

6. Applicant's arguments filed 11/3/06 have been fully considered but they are not persuasive.

Applicant argues that Ching does not disclose both the first cylindrical member and the second cylindrical member having a longitudinal axis extending in a longitudinal

direction, the first plate and the second plate moveable relative to one another in the longitudinal direction. Applicant goes on to argue that the plates of Ching move in a direction relative to one another that is perpendicular to the longitudinal axis of the stent of Ching.

In response, the Examiner maintains that for the purposes of the above rejection with respect to Ching, the longitudinal direction of the cylindrical members (see Fig. 5) and the plates (see Figs. 2 and 6) have been treated as being different because the claims are directed solely to the positioning assembly and not the combination of the positioning assembly and first and second cylindrical members. In Fig. 5 of Ching, both the first cylindrical member and the second cylindrical member have a longitudinal axis extending in a longitudinal direction. In Fig. 2 of Ching, the first plate (20) and the second plate (50) are moveable relative to one another (col. 4, lines 26-30) in the longitudinal direction [see Fig. 2, wherein the second plate (50) is inherently inserted first and placed in member (30) then the first plate (20) is moved longitudinally so as to slide above plate (50) into groove (34) of member (30)]. Therefore, both the first cylindrical and the second cylindrical member have a longitudinal axis extending in a longitudinal direction which is separate and distinct from the first plate and the second plate that are moveable relative to one another in the longitudinal direction as described above in detail.

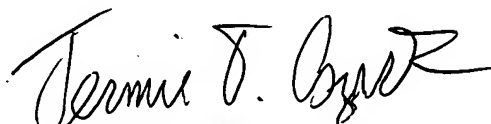
***Allowable Subject Matter***

7. Claims 3, 8, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 20-22 are allowed.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 13, 2006

  
JERMIE E. COZART  
PRIMARY EXAMINER